

## **REMARKS/ARGUMENTS**

Claims 1 - 65 are pending in this application.

### **Restriction Requirement**

In the Office action mailed January 24, 2005, the Office restricted the application to the following Groups of claims:

- I. Claims 1-54, drawn to a method of adding lipid-based inclusions to a filling suitable for flavoring yogurt, classified in class 426, subclass 583.
- II. Claims 55-65, drawn to 55-65 (*sic*), classified in class 426, subclass 583.

### **Election**

Applicant elects group I, *i.e.*, claims 1 - 54, *with traverse*.

The Office makes the case that the claims of groups I and II are distinct or independent:

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process.

Because there inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

(Office action of January 2, 2005, page 2.)

Applicant submits that restriction is not proper in this instance. MPEP § 803 states the requirement for a *proper* restriction.

There are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent or distinct as claimed; and (B) **There must be a serious burden on the examiner if restriction is required.**


(MPEP § 803, citations omitted, emphasis added.) Thus, there are *two* requirements for restriction: independence or distinctness *and* a serious burden. Both are required; independence or distinctness without a serious burden is not sufficient to justify restriction. Section 803 explicitly states that “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.”

Applicant respectfully submits that restriction is not proper in this case. While the claims of Groups I and II may satisfy the Office’s requirements for distinctness or independence, their consideration would hardly result in a serious burden on the Office. Groups I and II are, in fact, classified in the same class and subclass. Applicants respectfully request that the restriction requirement be withdrawn.

If issues relating to this application can be resolved by discussion, the Examiner is invited to contact the undersigned attorney by telephone.

Respectfully submitted,

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